

Application No. 09/656,440

REMARKS

Reexamination and reconsideration is respectfully requested in light of the following remarks.

Claims 1, 5, 6 and 11-13 are pending in this application. Claim 13 was previously amended. Claims 2-4 and 7-10 were canceled by previous amendments. The objection of claim 13 has been withdrawn in view of the amendment to claim 13 in the last response.

It is proposed to amend claims 1 and 12 to recite "compressing all of said plural pages using the decided parameters for the job" to clarify that the "decided parameters" apply to all of the pages for the job. This amendment does not raise an issue of new matter and is supported at page 4, lines 20 and 21 of the specification. Also, the amendment does not raise any new issues requiring further search and consideration because claims 1 and 12 require "processing plural pages of a job" (emphasis added). Accordingly, it is respectfully requested that the amendment be entered and the amended claims considered in light of the prior art relied upon by the Examiner.

Rejection Of Claims Under 35 U.S.C. § 103

Claims 1, 5, 6 and 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki et al. (U.S. Patent No. 5,828,780) in view of Ito et al. (U.S. Patent No. 5,884,120). The Examiner repeated the reasons in the previous Office Action for the rejection and made the rejection final. Independent claims 1 and 12 have been amended to clarify that in the job, all of the pages are subject to the same "decided parameters." Thus, the same color is applied to each and every page in the job. This feature is not taught by the prior art relied upon by the Examiner.

According to the Examiner, the arguments presented in the last response to this rejection were not persuasive because Suzuki et al. teach "(i) determining the data is within the color

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reproduction range of the output device ... and (ii) selecting the parameters ... that would provide uniform color production of all of the pages of the print job" (underscoring added). Suzuki et al. do not disclose or suggest item (ii). The reference speaks in terms of "an image," and not of a file that contains a plurality of pages. See Figs. 18 and 19. Further, the argument by the Examiner in item (ii) is inconsistent with the Examiner's findings regarding the teaching of Suzuki et al. The Examiner made a finding in the final rejection that Suzuki does not disclose image data comprising a plurality of pages. In the rejection, the Examiner stated: "Suzuki fails to teach an image processing apparatus having a memory for memorizing all of the plural pages of the job and wherein image data as taught by Suzuki comprising a plurality of pages." Accordingly, the Examiner's argument with respect to item (ii), *supra*, lacks merit.

The Examiner further argues that Suzuki et al. disclose a plurality of storage areas and concludes from this teaching that "[i]t is well known [i.e., common knowledge] that these storage areas can store plurality of image data or files depending on its storage capacity." The Examiner has not relied on any specific teaching of Suzuki et al. or Ito et al. to support this conclusion. Reliance on common knowledge does not fulfill the Examiner's obligation to cite references in support of his or her conclusion. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

The Examiner concludes that a "[d]ocument with plurality of pages [is] well known in the art and widely used in the art." For support, the Examiner relies on Ito et al. The Examiner states in the response to Applicant's arguments that "Suzuki's disclosure refers document data as an 'image data' or 'document data' as taught by Suzuki is not limited to just one page, but can also contain a plurality of pages (as taught by Ito)." The reasons for making this conclusion are

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not explained in the Office Action. The Suzuki "image data" is not equated to "document data". Suzuki et al. do not use the term "document data." Further, as concluded by the Examiner, Suzuki et al. fail to disclose processing "plural pages" as required by the rejected claims. Ito et al. likewise do not disclose processing "plural pages," but a single page on which up to four color images are placed (col. 6, lines 13-25). The combined teachings of Suzuki et al. and Ito et al. would have led a person having ordinary skill in the art to process image data which includes up to four images per page. The combined images do not suggest nor would the teachings have motivated such a person to memorize "plural pages of the job" and color compressing "all of said pages using the decided parameters" as required by the first and third steps set forth in the claims.

The Examiner noted that he relies upon Ito et al. only to show that "image data" data is not limited "to just one page, but also [to a] plurality of pages." There is no support for this finding in Ito et al. In the summary of their invention, Ito et al. state that the "apparatus has an image reader for reading an image of a document, and a print device ... for forming a color image ... on a sheet of paper from image data of the plurality of documents." Nowhere does Ito et al. disclose or suggest, let alone teach, that memorizing a plurality of pages and color compressing all of the plural pages as required by the claims.

For all of the foregoing reasons, the Examiner has not established a *prima facie* case of obviousness. It is respectfully requested that rejection of claims 1, 5, 6 and 11-13 under 35 U.S.C. 103(a) be reconsidered and withdrawn.

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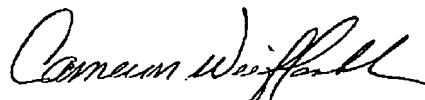
Conclusion

It is respectfully requested that the proposed amendment be entered and that favorable consideration be given to all of the claims of this application, However, should the Examiner consider that some or all of the claims would be allowable if further amended in a specific manner, the Examiner is requested to contact Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. § 1.17 and due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



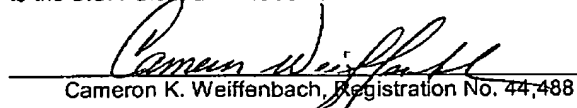
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Date: March 27, 2007